UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,017	02/14/2001	Hiroshi Kamiya	Q63036	3808

7590　　　　01/04/2007 SUGHRUE, MION, ZINN, MACPEAK & SEAS 2100 Pennsylvania Avenue, N.W. Washington, DC 20037	**EXAMINER** THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
3627	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

		Application No.	Applicant(s)
Office Action Summary		09/782,017	KAMIYA, HIROSHI
		Examiner	Art Unit
		Marissa Thein	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>October 16, 2006</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants' "Amendment under 37 C.F.R. § 1.111" filed on October 16, 2006 has

been considered.

New claims 38-47 have been added. Claims 1-47 remain pending in this

application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 7, 10, and 13-37 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 6,578,014 to Murcko, Jr. in view of U.S. Patent

No. 4,926,325 to Benton et al.

Regarding claims 1, 4, 7, 10, and 37, Murcko discloses a commodity order

issuing and accepting method, system and apparatus comprising:

- providing an order issuing device of electronic communications (buyer's

  interface, modem; Figure 1);

- providing an order accepting device capable of electronic communications (seller

  interface, modem; Figure 1);

- the requesting a first electronic document comprising first input fields for accepting order issuer information and for accepting commodity order issuance information except for an order issuer's payment date from said order accepting device (Figure 14; Buyer Registration Form; col. 23, line 46- col. 24, line 7; col. 22, line 28);

- the transmitting the first electronic document from the order accepter side to the order issuing device (Figure 14; Buyer Registration Form; col. 23, line 46- col. 24, line 7; col. 22, line 28);

- the inputting the order issuer information and the commodity order issuance information (Figure 14; Buyer Registration Form; col. 23, line 46- col. 24, line 7; col. 22, line 28);

- the transmitting the order issuer information and the commodity order issuance information except for said order issuer's payment date to said order accepting device (col. 23, line 61 – col. 24, line 2);

- the retrieving a transaction condition corresponding to the commodity order issuance information on the order accepting device (col. 22, lines 34-57); and

- the transmitting a second electronic document on which the transaction condition is described and which has a second input field for said order issuer's payment date to said order issuing device (Figure 18).

However, Murcko does not explicitly disclose inputting the order issuer's payment date and transmitting the order issuer's payment date. Murcko discloses payment date stores the date on which the buyer assigns the payment amount for this item (col. 16,

lines 59-61). Furthermore in Figure 18, a payment date input field is shown, wherein the buyer sets the payment amount for an item, the date/time on which this happens will subsequently appear (col. 28, lines 26-30).

Benton, on the other hand, teaches the inputting the order issuer's payment date and transmitting the order issuer's (buyer) payment date (col. 9, lines 51-54; col. 16, lines 30-32; col. 16, lines 38-42). Benton teaches a system and method for carrying out funds data transfer between buyers and sellers in a common location, a local mode of operation, or at different locations in a remote mode (col. 2, lines 50-52; col. 2, lines 59-61). Benton further teaches the prompting of the buyer to enter the date and time of the proposed transaction (col. 16, lines 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system, and apparatus of Murcko, to include the inputting and transmitting of the order issuer's payment date, as taught by Benton, in order to provide the buyer payment options (Benton col. 16, lines 30-33).

Regarding claims 13-20, Murcko substantially discloses the claimed invention, however, it does not explicitly disclose the order issuer's payment date is a proposed payment date and is manually entered by a user. Murcko discloses payment date stores the date on which the buyer assigns the payment amount for this item (col. 16, lines 59-61). Furthermore in Figure 18, a payment date input field is shown, wherein the buyer sets the payment amount for an item, the date/time on which this happens will subsequently appear (col. 28, lines 26-30).

Benton, on the other hand, teaches the order issuer's payment date is a proposed payment date and is manually entered by a user (col. 9, lines 51-54; col. 16, lines 30-32; col. 16, lines 38-42). Benton teaches a system and method for carrying out funds data transfer between buyers and sellers in a common location, a local mode of operation, or at different locations in a remote mode (col. 2, lines 50-52; col. 2, lines 59-61). Benton further teaches the buyer to elect to carry out the transaction immediately or prompting of the buyer to enter the date and time of the proposed transaction (col. 16, lines 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system, and apparatus of Murcko, to include the order issuer's payment date is a proposed payment date and is manually entered by a user, as taught by Benton, in order to provide the buyer payment options (Benton col. 16, lines 30-33).

Regarding claims 21-32, Murcko discloses HTML format (col. 14, lines 62-63), Internet (col. 3, lines 58-59), and a transaction condition is a formula related to a commodity transaction (col. 27, line 57 – col. 28, line 14).

Regarding claims 33-36, Murcko discloses the order issuer's information is at least one of an order's issuer's name, an order issuer's address and an order issuer's telephone number (Figure 14).

Regarding claims 38-42, Murcko discloses the commodity order issuance information is a commodity item (Figures 17-18; col. 27, lines 20-23).

Claims 2-3, 5-6, 8-9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,578,014 to Murcko, Jr. and U.S. Patent No. 4,926,325 to Benton et al. as applied to claims 1, 4, 7, and 10 above, and further in view of U.S. Patent No. 6,314,406 to O'Hagan.

Regarding claims 2-3, 5-6, 8-9, and 11-12, Murcko and Benton substantially discloses the claimed invention, however, the combination does not explicitly disclose the calculating reduced price corresponding to the transaction condition; transmitting a third electronic document on which the reduced price is described and which has means for imputing an authentication to said order issuing device; activating the means for inputting the authentication; and transmitting information representing that said means for inputting the authentication has been activated to said order accepting device.

O'Hagan teaches calculating a reduced price corresponding to the transaction condition (col. 21, lines 15-16; Figure 32; col. 23, lines 42-52; col. 28, lines 45-50; col. 32, lines 1-3). O'Hagan further teaches transmitting a third electronic document on which the reduced price is described and which has means for imputing an authentication to said order issuing device; activating the means for inputting the authentication; and transmitting information representing that said means for inputting the authentication has been activated to said order accepting device (col. 17, lines 20-56; col. 28, lines 44-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include calculating a

reduced price, as taught by O'Hagan, in order to obtain a discount on a product (O'Hagan, col. 1, lines 39).

Claims 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,578,014 to Murcko, Jr. and U.S. Patent No. 4,926,325 to Benton et al. as applied to claims 1, 4, 7, and 10 above, and further in view of U.S. Patent No. 6,405,174 to Walker et al.

Regarding claims 43-47, Murcko and Benton substantially discloses the claimed invention, however, the combination does not explicitly disclose a regular payment amount and a payment due date, the regular payment amount being due on the payment due date, and wherein the payment amount and the payment due date are determined by the order accepting device.

Walker, on the other hand, teaches the regular payment amount and the payment due date, the regular payment amount being due on the payment due date, and wherein the payment amount and the payment due date are determined by the order accepting device (col. 7, lines 8-26)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the regular payment amount and the payment due date, as taught by Walker, to provide payment in a timely manner.

Response to Arguments

Applicant's remarks filed October 16, 2006 have been fully considered but they are not persuasive.

Applicant remarks that "one skilled in the art would not have combined the

teachings as suggested by the Examiner, and the Examiner has failed to make a *prima*

facie case of obviousness".

The Examiner does not agree. Examiner notes that Murcko discloses a method

and apparatus for a commercial network system designed to facilitate transaction (col.

3, lines 42-44). A buyer logs on to the system, views items that have been provided to

him/her by the seller, and optionally specifies payment amounts for those items or

request addition information from the seller (col. 4, lines 26-29). After the buyer has

sent the payment to the system operator to cover the items, the system operator sends

a payment to the seller (col. 4, lines 29-31). Furthermore, Murcko teaches a payment

date which is stored in the Item database, that stores the date on which the buyer

assigns the payment amount for the item (col. 16, lines 59-61). Moreover, in Figure 18

buyer views items page, which enables buyers to view all the items that seller have

provided to the buyer and optionally sets payment amounts for this item (col. 28, lines

15-19). When the buyer sets the payment amount for an item, a payment date input

field subsequently appears (Figure 18 ref. 1812) (col. 28, lines 26-30). The Examiner

then turns to Benton to teach the inputting the order issuers' payment date and

transmitting the order issuer's payment date. Benton teaches a system for carrying out

funds data transfer between buyers and sellers (col. 2, lines 50-52). Benton teaches a

buyer at a remote location enters his card and is prompted to enter his personal

identification number (col. 9, lines 38-40). If there are sufficient funds, the buyer is then

prompted to enter the seller's account number together with authorization code and

transaction amount and depresses the ENTER Key (col. 9, lines 40-51). The buyer is

then prompted for a time and date after which the transaction is permitted to proceed

(cool 9, lines 51-53). The buyer then depresses the ENABLE TRANSACTION key (col.

9, lines 55-56).

The motivation to combine is then found in Benton to provide the buyer payment

options (col. 16, lines 30-33).

Applicant remarks that "Applicant submits that the Examiner has improperly

shifted the meaning of the claimed transaction condition between the independent

claims and their corresponding dependent claims".

The Examiner does not agree. Examiner notes that Murcko does disclose the

transaction condition recited in claims and Examiner did not improperly shift the

meaning. Murcko discloses a buyer item request form, which specify the specific items

or types of items (col. 27, lines 20-23). The form specifies the types of sellers they are

interested in buying such items from and other required seller criteria (col. 27, lines 24-

27). Each of the buyer's specific request form is matched with sellers who meet the

required criteria. The sellers receive the item request form. (Col. 27, lines 62-63) The

buyer can also provide guidance to what payment amount they might be willing to pay

for the desired amount item (col. 27, lines 63-67). A buyer can specify a cutoff

percentile for sellers providing items or for each item request he/she makes (col. 28,

lines 1-6). The buyer can only choose from among those sellers who are willing to

accept item requests from the buyer who meet the sellers' requirements, such as the

buyer having an average payment of at least a certain amount (i.e. a cutoff percentile

for the buyers) (col. 28, lines 7-14). The buyer then receives a buyer view items page, which enables buyers to view all items that match the buyer request forms with the sellers' requirements (col. 28, lines 14-16). The page includes item information and description and payment amount, and the buyer having the ability to view a previously set payment amount (col. 28, lines 18-26).

Such buyer item request form, which specify the specific items or types of items; the form specifies the types of sellers they are interested in buying such items from and other required seller criteria; buyer's specific request form is matched with sellers who meet the required criteria; buyer can also provide guidance to what payment amount they might be willing to pay for the desired amount item; buyer then receives a buyer view items page which enables buyers to view all items that match the buyer request forms with the sellers' requirements, such as the buyer having an average payment of at least a certain amount (i.e. a cutoff percentile for the buyers); and the buyer view items page includes item information and description, payment amount and the buyer having the ability to view a previously set payment amount are considered "the transaction condition is a formula related to a commodity transaction".

Applicant remarks that "the Examiner has failed to make a *prima facie* case of obviousness".

The Examiner does not agree. Examiner notes that Murcko discloses a method and apparatus for a commercial network system designed to facilitate transaction (col. 3, lines 42-44). A buyer logs on to the system, views items that have been provided to him/her by the seller, and optionally specifies payment amounts for those items or

request addition information from the seller (col. 4, lines 26-29). After the buyer has

sent the payment to the system operator to cover the items, the system operator sends

a payment to the seller (col. 4, lines 29-31). Furthermore, Murcko teaches a payment

date which is stored in the Item database, that stores the date on which the buyer

assigns the payment amount for the item (col. 16, lines 59-61). Moreover, in Figure 18

buyer views items page, which enables buyers to view all the items that match with the

sellers, and optionally sets payment amounts for this item (col. 28, lines 15-19). When

the buyer sets the payment amount for an item, a payment date input field subsequently

appears (Figure 18 ref. 1812) (col. 28, lines 26-30). The buyer views item page is a

result of matching a buyer's specific request form with the sellers who meet the buyer's

required criteria (col. 27, lines 62-63). The buyer can also provide guidance to what

payment amount they might be willing to pay for the desired amount item (col. 27, lines

63-67). A buyer can specify a cutoff percentile for sellers providing items or for each

item request he/she makes (col. 28, lines 1-6). The buyer can only choose from among

those sellers who are willing to accept item requests from the buyer who meet the

sellers' requirements, such as the buyer having an average payment of at least a

certain amount (i.e. a cutoff percentile for the buyers) (col. 28, lines 7-14). The buyer

then receives a buyer view items page, which enables buyers to view all items that

match the buyer request forms with the sellers' requirements (col. 28, lines 14-16). The

buyer views item page includes item information and description and payment amount,

and the buyer having the ability to view a previously set payment amount (col. 28, lines

18-26).

The Examiner then turns to Benton to teach the inputting the order issuers'

payment date and transmitting the order issuer's payment date. Benton teaches a

system for carrying out funds data transfer between buyers and sellers (col. 2, lines 50-

52). Benton teaches a buyer at a remote location enters his card and is prompted to

enter his personal identification number (col. 9, lines 38-40). If there are sufficient

funds, the buyer is then prompted to enter the seller's account number together with

authorization code and transaction amount and depresses the ENTER Key (col. 9, lines

40-51). The buyer is then prompted for a time and date after which the transaction is

permitted to proceed (cool 9, lines 51-53). The buyer then depresses the ENABLE

TRANSACTION key (col. 9, lines 55-56).

The motivation to combine is then found in Benton, to provide the buyer payment

options (col. 16, lines 30-33).

The Examiner then turns to O'Hagan to teach the calculating reduced price

corresponding to the transaction condition; transmitting a third electronic document on

which the reduced price is described and which has means for imputing an

authentication to said order issuing device; activating the means for inputting the

authentication; and transmitting information representing that said means for inputting

the authentication has been activated to said order accepting device. O'Hagan teaches

a shopping system network which includes a host computer coupeable to a network and

a customer computer coupleable to the network (col. 4, lines 11-13). The customer

computer is a portable transaction computer (col. 6, lines 57-58). The customer

computer includes buttons such as Pay cash button, debit card button and a credit card

button (Figure 18). O'Hagan further teaches a confirmation page which includes

discounts and term on coupons and discounts (col. 21, lines 13-16). Moreover,

O'Hagan teaches a receipt which includes instruction to launch a running total program

and a data filed indicating whether the item is to be added or removed from the

customer's running total (col. 17, lines 21-27). When the customer has finished

shopping, the customer activates the checkout button and causes the customer

computer to generate a link request for the checkout page (col. 17, lines 37-40). The

checkout form page includes the customer receipt and includes virtual buttons where

the customer is offered option of payments (col. 17, lines 42-51).

The motivation is then found in O'Hagan, to obtain a discount on the product (col.

1, line 39).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
December 26, 2006

MICHAEL CUFF
PRIMARY EXAMINER